

## **REMARKS**

### **I. Status of the Application**

In view of the above amendments and the following remarks, reconsideration of the rejections set forth in the Office Action of July 18, 2011 is respectfully requested.

By this amendment, claims 6, 58, and 67 have been amended, and claims 6 and 57-69 are now pending in the application. No new matter has been added by these amendments.

### **II. Improper Finality**

Withdrawal of the finality of the Office Action is respectfully requested. MPEP 706.07(b) states that first action finality is only proper if the application “would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114.” The response of March 9, 2011 includes claim amendments and new dependent claims which raise substantial new issues and thus would not have been entered absent the filing of an RCE. Importantly, the new issues raised in the previous response have not been appropriately addressed by the Examiner. Moreover, the pending claims could not have been properly finally rejected on the grounds of record, as clearly evidenced by the fact that the Examiner asserts a new grounds of rejection based on optimization of ranges. Further still, the pending claims could not have been properly finally rejected on the art of record because, as discussed in more detail below, the standing prior art rejections are deficient as a matter of law. Accordingly, withdrawal of the finality of the Office Action is in order.

### III. 35 U.S.C. § 112

Claims 6 and 57-69 currently stand rejected under 35 U.S.C. § 112 as being indefinite and as failing to comply with the enablement rejection. Applicants traverse these rejections as provided below.

The indefiniteness and enablement rejections are based on subject matter which is not recited in the pending claims, and thus these rejections are improper. Specifically, the copper content of “10 to 95wt%” has been removed from the claims, and thus rejection of these claims based on this subject matter is improper.

The standard for indefiniteness is “whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986), see also MPEP 2173.02 and *Beachcombers v. Wildewood Creative Prods.*, 31 F.3d 1154, 1158 (Fed. Cir. 1994). Thus the standard for indefiniteness is based on the claims, and there is no basis in the law for rejecting claims over subject matter which is not recited in the claims.

The standard for enablement is whether a person of ordinary skill in the art could make and use the invention without undue experimentation. See *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916), and see also MPEP 2164.01. Of course, the invention is defined in the claims, and thus there is no basis for rejecting claims as being non-enabled over composition ranges which are not recited in the claims. In fact, the enablement rejection itself appears to concede this fact because it refers to “claimed ranges that result in greater than 100% total weight” (see page 3, lines 14-15 of the Office Action). No such conflicting claimed ranges exist in the currently pending claims, and thus this rejection is improper.

In view of the above, withdrawal of the enablement and indefiniteness rejections is respectfully requested.

#### IV. Prior Art Rejections

Claims 6, 57, 62, 63, 65, 66, and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takeshi (JP 08-109450), and the remaining claims stand rejected as being obvious over Takeshi in view of various other prior art references. Applicants traverse these rejections as provided below.

Claim 6 recites that the sintered compact has a relative density of at least 80%, relative density being defined as a ratio of sintered density to true density of the sintered material. Page 5 of the Office Action refers vaguely to the translation of the Takeshi reference attached to the Office Action of January 15, 2010. However, no disclosure of this subject matter could be found in the translation referenced by the Examiner. At the bottom of page 6 of the Office Action, the Examiner appears to refer to a translation of another prior art reference; this document does not appear to be of record, and the DE 7342680 reference is not cited as a basis for the rejection of claim 6 or any other claim. Applicants **specifically request** that the Examiner explain precisely where this subject matter is disclosed in the prior art, **as required by the MPEP**<sup>1</sup>.

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<sup>1</sup> “When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” MPEP 2260, emphasis added.

“The first Office action must be sufficiently detailed that the pertinency and manner of applying the cited prior art to the claims is clearly set forth therein.” MPEP 2262, emphasis added.

“In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.” MPEP 707.07(f), emphasis added.

“The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.” MPEP 706.07.

Additionally, the prior art rejection again fails to establish that molybdenum oxide is a result effective variable, as discussed at length on pages 9 and 10 of the response of March 9, 2011. In particular, merely asserting that a substance has an effect on properties such as density, thermal conductivity, etc. is not evidence of result-effectiveness. Accordingly, the prior art rejection fails to account for all of the differences between the present invention and the applied prior art, and thus no prima facie case of obviousness has been established.

Lastly, the claimed sliding member having a sintered compact containing Mo in an amount of 35 to 70 wt% is suitable for a high-speed and high-bearing stress sliding material with excellent abrasion resistance and seizing resistance, as discussed in the specification. According, the distinguishing claim limitations discussed above result in significant advantages and unexpected results which are not achieved in the prior art of record.

Further, it appears as though there would have been no reason to modify any of the prior art of record to yield a configuration which would meet the requirements of claim 6. It is thus submitted that the invention of the present application, as defined in claim 6, is not anticipated nor rendered obvious by the prior art, and yields significant advantages over the prior art. Allowance is respectfully requested.

Claim 67 requires limitations identical to those discussed above with respect to claim 6, and is thus allowable for the same reasons. Claims 57-66 and 69 depend from claim 6 and claim 68 depends from claim 67, and thus these claims are allowable at least by virtue of their dependencies.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, it is respectfully submitted that the present application is now in condition for allowance, and action to such effect is earnestly solicited. If any issues remain

after consideration of the response, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,

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